

REMARKS

Claims 3-11, 13-16, and 22-29, and 32-36 are pending. Claims 30 and 31 are currently canceled. Claims 1, 2, 12, and 17-21 were previously canceled. Claims 26-29 and 32 have been withdrawn from consideration. Claims 3, 5, 24-27, 33, and 34 are currently amended. New claims 35 and 36 have been added.

Reconsideration of the application, as amended, is requested.

Support for the amendments to claims 33 and 34, with respect to R^2 being hydrogen can be found in the specification, for example, page 6, line 20.

Support for new claims 35 and 36 can be found in the application as filed. The limitation in claim 35, where R^1 is dihydroxyalkyl, and the limitation in claim 36, where R^1 is dihydroxypropyl and R^2 is hydrogen, are supported by the specification, for example, Examples 1 and 3 on page 19 and Example 7 on page 21, where "APD" is defined as 2-amino-1,3-propanediol on page 17. Further support for R^2 is hydrogen can be found in the specification, for example, page 6, line 20. In claim 36, R^1 and R^2 are defined, in part, as independently hydrogen, hydroxyalkyl or polyalkylenepolyamine, which is supported, for example, by original claim 2. Further argument for the term "dihydroxyalkyl" as implicitly disclosed in the application is provided below.

Support for the amendments to claims 24 to 27, with respect to the definition of Y, can be found in the specification, for example, page 7, lines 1-3.

Objection to Amendments

It was noted that applicants' previous amendments to the specification and the claims fail to comply with the provisions of 37 CFR 1.121.

Firstly, it was noted that the amendment to page 34 of the specification was improper, because the WIPO number was improperly changed to WO 02/30484 and without the required underlining and strikethrough. Also, it was noted that the number does not agree with that set

forth within the amended table on pages 34 and 35. Applicant submits that the previous amendment to the specification inadvertently incorrectly referred to pages 34 and 35 instead of 23 and 24. Therefore, Applicant understands this objection to relate to pages 23 and 24 of the specification.

In response, Applicants have amended the specification on page 23 to agree with the original disclosure. Applicants have amended the WIPO number table in the table on page 24 to agree with the number provided on page 23. Although the specification has been amended to agree with the original disclosure, Applicants submit that the original disclosure contained an error, and the Comparative Example that was actually prepared and tested for the present application was Example 15 from WO 02/30848.

Secondly, it was noted that claims 8 and 9 were identified as Previously Presented; however, deleted subject matter was set forth within each claim.

Applicants regret that deleted subject matter was set forth within claims 8 and 9. The deleted subject matter has now been removed, and the claims retain the correct status identifier "Previously Presented".

Thirdly, new claims 33 and 34 were said to be improper because subject matter was improperly set forth with underlining.

Applicants regret that commas were set forth with underlining in new claims 33 and 34. The underlining of these commas has now been removed.

Objection to Disclosure

The disclosure was objected to because of the following informalities: the WIPO number is inconsistent between the disclosure on page 34 and the amended table.

As mentioned above, the amendment to the specification submitted herewith changes the WIPO number listed in the table on page 24 to match the disclosure on page 23.

The amendment filed August 5, 2008 was objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. The added material which was said to be not

supported by the original disclosure is as follows: the amendments to the specification indicating that Example 15, as opposed to Example 50, of WO 02/30484 (or WO 02/3848) is the comparative example.

As described above, Applicants have amended the specification to refer to Example 50 to agree with the originally filed specification.

§ 112 Rejections

Claims 3-11, 13-16, 22-25, 33, and 34 were rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

Firstly, the Office Action indicates that the specification lacks support for the R¹ and R² species, "dihydroxyalkyl", set forth within claims 24 and 25 (and nonelected claims 26 and 27). In particular, support was not found within lines 13 to 17 of page 4 or on page 26.

Applicants traverse the rejection and submit that one skilled in the relevant art would have understood that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants respectfully point out that according to MPEP § 2163.02, "The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Also, MPEP § 2163.05 states, "To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim must be expressly, implicitly, or inherently supported in the originally filed disclosure."

Applicants submit that the limitation, where R¹ and R² are each independently dihydroxyalkyl, is implicit in the original disclosure. The limitation, where R¹ and R² are each independently dihydroxyalkyl, is supported by the specification, for example, Examples 1 and 3 on page 19 and Example 7 on page 21, where "APD" is defined as 2-amino-1,3-propanediol on page 17. These Examples should be taken into consideration with the disclosure, for example, on page 3, lines 8-10, where it states, "R¹ and R² are each independently hydrogen, hydroxyalkyl, or polyalkylenepolyamine", which indicates to one skilled in the art that hydroxyalkyl groups, in general, can be used for R¹, R², or both. Since similar methods are used to make compounds of formula I having hydroxyalkyl or dihydroxyalkyl groups, and since

hydroxyalkyl groups in general were disclosed, one skilled in the art reading the specification would understand that the inventors were in possession of dihydroxyalkyl groups generally and the exemplified dihydroxypropyl group at the time the application was filed.

Secondly, the present amendment of claim 5, which is supported by the specification, for example, page 9, lines 19-23, overcomes the rejection of claim 5 under 35 USC § 112, first paragraph.

In view of these arguments and amendments, Applicants request withdrawal of the rejection of claims 3-11, 13-16, 22-25, 33 and 34 under 35 USC § 112, first paragraph.

Double Patenting

Claims 3-11, 13-16, 22-25, 33, and 34 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-4, 6-10, and 18-24 of copending Application No. 10/729,073. This was a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants may provide a terminal disclaimer, if appropriate, once one of the applications in question has issued, and the rejection is no longer provisional.

§ 102 Rejections

Claims 5-11, 13-16, 22-25, 33, and 34 were rejected under 35 USC § 102(e) as being anticipated by Moore et al. (U.S. Patent No. 6,649,272).

Applicants wish to withdraw the argument that the rejection of the claims under 35 USC § 102(e) as being anticipated by Moore et al. (U.S. Pat. No. 6,649,272) is rendered moot because the '272 patent is derived from the inventor of this application and is not the invention by "another". Further, Applicants confirm that no declaration under 37 CFR § 1.132 was submitted with regard to Moore et al. Instead, Applicants have amended claims 24 and 25 and provide the following arguments to overcome the rejection.

Applicants traverse the rejection of claims 24 and 25 under 35 USC § 102(e) as being anticipated by Moore et al. because the reference does not disclose a composition as described in claim 24 or claim 25, as amended.

The composition, as recited in amended claims 24 and 25, comprises a perfluoropolyether urethane or urea silane, or a mixture thereof which is the reaction product of a specific fluorinated polyether compound of formula (I) that includes carboxylic acid ester or carboxamide groups and isocyanate reactive groups (T and T') and a specific silane compound of formula (II). The amendments to claims 24 and 25 eliminate the possibility that the isocyanate reactive group can be -COOH, which can result in the formation of an amide, and thereby more clearly differentiate these claims from Moore et al. Moore et al. discloses a urethane composition (FES-2, see column 13, line 21-30) and amide compositions. However, the reference does not suggest, disclose or claim silanes that can be prepared from a silane-substituted isocyanate and a fluorinated polyether compound containing both (a) carboxylic acid ester or carboxamide groups and (b) hydroxyl or amino groups, as required by the definitions of T and T' of claims 24 and 25, as amended.

Since Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II), the reference does not anticipate Applicants' amended claims 24 and 25.

Claims 5-11, 13-16, 22, 23, 33, and 34 all depend, either directly or indirectly, from claim 24 or 25. Thus, each of these claims is patentable at least on the basis of this dependency from a patentable base claim.

The rejection of claims 5-11, 13-16, 22-25, 33, and 34 under 35 USC § 102(e) as being anticipated by Moore et al. (U.S. Pat. No. 6,649,272) has been overcome and should be withdrawn.

Claims 5-11, 13-16, and 22-25, are rejected under 35 USC § 102(b) as being anticipated by WO 02/30848.

With regard to this reference, the Office Action states in paragraph 13:

Applicants have argued that T and T' represent a -CO₂R³ group or a -C(O)N(R¹)(R²) group, whereas WO 02/30848 recites compositions that contain urethane linkages. In response, WO 02/30848 clearly discloses

page 5, line 14 and page 6, line 5 that the preferred linking group is an amide group, and the position is taken that the same compound would result from the reaction of an isocyanate functional silane with a carboxyl functional fluorinated polyether, since isocyanate groups react with carboxyl groups to yield amide groups. Accordingly, these preferred teachings are considered to satisfy applicants' claim limitations. Furthermore, arguments pertaining to superior or unexpected results are not germane to the issue of anticipation. However, even if such showings were germane, applicants' argued showings would be insufficient in view of the disclosed preference for amide groups, since the comparative urethane containing compounds would not be representative of the closest relied on teachings.

The amendments to claims 24 and 25 eliminate the possibility that the isocyanate reactive group can be -COOH , which can result in the formation of an amide, and thereby more clearly differentiate these claims from WO 02/30848. Since WO 02/30848 fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II), the reference does not anticipate Applicants' amended claims 24 and 25.

Claims 5-11, 13-16, 22 and 23 all depend, either directly or indirectly, from claim 24 or 25. Thus, each of these claims is patentable at least on the basis of this dependency from a patentable base claim.

The rejection of claims 5-11, 13-16, and 22-25 under 35 USC § 102(b) as being anticipated by WO 02/30848 has been overcome and should be withdrawn.

§ 103 Rejections

Claim 4 is rejected under 35 USC § 103(a) as being unpatentable over Moore et al. (U.S. Pat. No. 6,649,272) or WO 02/30848, each in view of Brown (U.S. Pat. No. 6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As stated above in response to the rejection of claims 5 – 11, 13 – 16, 22 – 25, 33, and 34 under 35 USC § 102(e), Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown (6,495,624), Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the

present application are nonobvious over Moore et al., in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As stated above in response to the rejection of claims 5 – 11, 13 – 16 and 22 – 25 under 35 USC § 102(b), WO 02/30848 fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown (6,495,624), Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the present application are nonobvious over WO 02/30848, in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

The rejection of claim 4 under 35 USC § 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670 has been overcome and should be withdrawn.

Claim 3 is rejected under 35 USC § 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670, and further in view of WO 01/30873.

As stated above in response to the rejection of claims 5 – 11, 13 – 16, 22 – 25, 33, and 34 under 35 USC § 102(e), Moore et al. fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown (6,495,624), Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the present application are nonobvious over Moore et al., in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

As stated above in response to the rejection of claims 5 – 11, 13 – 16 and 22 – 25 under 35 USC § 102(b), WO 02/30848 fails to disclose the reaction product of a specific fluorinated polyether compound of formula (I) that includes isocyanate reactive groups (T and T') and a specific silane compound of formula (II). Neither Brown (6,495,624), Scicchitano et al. (US 2002/0016267) nor WO 01/34670 remedy this deficiency. Therefore, the claims of the present application are nonobvious over WO 02/30848, in view of Brown (6,495,624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670.

The rejection of claim 3 under 35 USC § 103(a) as being unpatentable over Moore et al. ('272) or WO 02/30848, each in view of Brown ('624) or Scicchitano et al. (US 2002/0016267) or WO 01/34670, and further in view of WO 01/30873 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application, as amended, is requested.

Respectfully submitted,

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